

## **REMARKS**

### **A. Status of the Claims**

Claims 49-100 were pending at the time of the Action. Claim 49 has been amended. Claims 50, 55-57, 72-74, and 91-93 have been canceled. No have been added. Therefore, claims 49, 51-54, 58-71, 75-90, and 94-100 are pending and presented herein for reconsideration.

### **B. The Obviousness Rejection is Overcome**

Claims 49-83 and 100 have been rejected under 35 U.S.C. § 103 as allegedly obvious over Shimizu (US 2005/0254148) in view of Moffatt (US 6,909,588) and Chen *et al.* (US 6,551,710). Applicants respectfully traverse.

#### **1. The cited references fail to teach or suggest all the elements of the current claims**

The cited references, alone and in combination, fail to teach a holder where “the second end portion of each arm comprises a material having a dielectric constant at 1 MHz equal to or higher than the dielectric constant of the optical lens material and greater than or equal to 3.0, and a specific heat ( $\text{kJ kg}^{-1} \text{K}^{-1}$ ) higher than the specific heat of the optical lens material and higher than  $1.2 \text{ kJ kg}^{-1} \text{K}^{-1}$ .” The failure of the cited references to teach or suggest each element of the current claims is fatal to an obviousness rejection. *See KSR Int ’l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))); *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)); *see also* MPEP § 2143.03.

First, none of the cited references, alone or in combination, teach or suggest a dielectric constant that is greater than or equal to 3.0. As acknowledged by the Examiner, Shimizu fails to

disclose any dielectric constant. The same is true with Chen. The only reference that mentions a dielectric constant is Moffatt, which discusses dielectric properties that are appropriate for the production of wafers for semiconductors, not for treating an optical lens. Moffatt does not teach or suggest that the holder (*i.e.*, the wafer holder comprising a compliant layer) would have a dielectric constant at 1 MHz equal to or greater than the dielectric constant of the article being held (*i.e.*, the wafer). Further, Moffatt teaches that “good dielectric properties” are *between* 1.0 and 3.0, and as such does not teach a dielectric constant that is 3.0 or higher. Therefore, none of the cited references teach or suggest a second end portion of each arm comprises a material having a dielectric constant at 1 MHz equal to or higher than the dielectric constant of the optical lens material as currently claimed.

Second, the cited references also fail to even mention specific heat of a material at all, much less teach or suggest a material that has a specific heat ( $\text{kJ kg}^{-1} \text{K}^{-1}$ ) higher than the specific heat of the optical lens material and higher than  $1.2 \text{ kJ kg}^{-1} \text{K}^{-1}$ .

For at least these reasons, the cited combination of references do not render the current claims obvious and the rejection should be withdrawn.

## **2. There is no apparent reason to combine the references as asserted**

In addition to the fatal flaw in the obviousness rejection as discussed above, there is no apparent reason why a person of ordinary skill in the art would have combined the cited references as asserted to arrive at the currently claimed invention. Shimizu discloses a lens holder which is designed specifically for a dipping process to apply a hard coating to a lens. *See, e.g.*, Shimizu at paragraphs [0014], [0018], [0040]. One aspect of this design is the focus on having minimal contact between the lens holder and the lens only on the outside edge of the lens to minimize defects in the lens that may occur as a result of the dipping process. *See, e.g.*,

Shimizu at paragraphs [0014], [0018]. In contrast, Moffatt concerns a support plate for a semi conductive wafer for photolithography engraving of the wafer with a high energy electron beam. The plate comprises a compliant layer (222) that is in substantial contact with and is parallel to the flat sides of the wafer (114) during engraving (this can be seen easily in Figure 2B). In fact, it is this substantial contact between the compliant layer and the wafer that allows the invention of Moffatt to function as intended, as the compliant layer aims at regularizing the thermal deformation of the wafer during engraving (column 6, lines 2-9). Modifying Moffatt to minimize contact between the holder and the wafer and to place the wafer orthogonally to the holder, as required by the current claims and to conform to the design of Shimizu, would destroy the functionality of the wafer holder of Moffatt. Obviousness cannot be established where the proposed modification destroys the functionality of the prior art composition or makes it unsatisfactory for its intended purpose. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); MPEP § 2143.01. Furthermore, as discussed above, Moffatt teaches that “good dielectric properties” are between 1.0 and 3.0. Therefore, Moffatt teaches away from using a material that has a dielectric constant at 1 MHz of 3.0 or more. Obviousness also cannot be established where the reference teaches away from the modification or combination. *See In re Grasselli*, 713 F.2d 731, 743, (Fed. Cir. 1983); MPEP 2145.

Chen appears to be relevant only for its brief mention of corona discharge treatments. Although Chen is cited for “treating the lens while it is in the holder” (Action at page 3), Applicant could not find a single appearance of the term “holder” in the document. Therefore, Chen does not teach or suggest treatment of a lens by a corona discharge treatment while it is in a holder.

Based at least on the above, the cited combination of references do not render the current claims obvious and the rejection should be withdrawn.

**C. Conclusion**

Applicants believe this paper to be a full and complete response to the Office Action dated June 23, 2011. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3123.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tamsen L. Barrett".

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